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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,685	01/18/2005	Junichi Oka	10921.0270USWO	2163
52835 7590 11/08/2007 HAMRE, SCHUMANN, MUELLER & LARSON, P.C. P.O. BOX 2902 MINNEAPOLIS, MN 55402-0902			EXAMINER WRIGHT, PATRICIA KATHRYN	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 11/08/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/521,685	OKA, JUNICHI	
	Examiner	Art Unit	
	P. Kathryn Wright	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-17 is/are rejected.
- 7) ☒ Claim(s) 7-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "the suction portion" in line 2 and the "disposing portion". There is insufficient antecedent basis for this limitation in the claim. It is not clear what applicant means by the limitations "suction portion" and "disposing portion".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-4 and 15-17 are rejected under 35 U.S.C. 102 (b) as being anticipated by Yokota ET al., (US Patent no. 5,560,470), hereinafter "Yokota".

Yokota teaches an analyzing device comprising a rotating body 25, 31 that holds the target analyte (test strip 1) by applying a negative pressure via a suction device (vacuum pump not shown, see col. 3, lines 5 et seq.) to the target analyte (test strip 1) while transferring the target analyte in a circumferential direction of the rotating body 25, 31 (see col. 5, lines 60 et seq. and Figs. 1-2)

Regarding claim 2, the rotating body of Yokota includes an inner space (hollow portion of shaft 31) for negative pressure application, a plurality of positioning portions each for placing and holding the target analyte (test strips 1), and through-holes 15, 17 for connecting the positioning portions and the inner space.

With respect to claims 15-16, Yokota teaches a section applying clearance (suction portion) between each positioning portion and the through-holes (col. 5, lines 45 et seq.). The suction portion is formed by a recess 14 smaller than the positioning portion (see Fig. 1).

Regarding claim 17, this claim appears to be merely describing the function or operation of the analyzing device. Only structural language is determinative of the

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metes and bounds of a patent claim. Applicant must establish that what is expressly taught by the prior art does not inherently function in the manner required by the claim.

6. Claims 1-3, 5-6, 13-14 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Murata (US Patent no. 6,582,659).

Murata teaches an analyzing device comprising a cylindrical rotating body 1 (reaction table) rotating body that holds the target analyte (test strip 14) by applying a negative pressure via a suction device 9 to the target analyte (test strip) while transferring the target analyte in a circumferential direction of the rotating body (see col. 5, lines 60 et seq. and Figs. 1-2)

Regarding claim 2, the rotating body of Murata includes an inner space (reads on space between base 15 underside of rotating body) for negative pressure application, a plurality of positioning portions 1a each for placing and holding the target analyte (test strips 14), and through-holes (slit formed at each groove) for connecting the positioning portions and the inner space. The positioning portions extend in an axial direction with respect to the rotating body and are spaced from each other in a circumferential direction of the rotating body (Fig. 1).

With respect to claims 13-14, Murata teaches a blade 7f for removing the target analyte on the positioning portion. The rotating body includes a guide portion (i.e., groove 1a) in which the target analyte is accommodated (col. 5, lines 45 et seq.)

Regarding claim 17, this claim appears to be merely describing the function or operation of the analyzing device. Only structural language is determinative of the

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metes and bounds of a patent claim. An applicant must establish that what is expressly taught by the prior art does not inherently function in the manner required by the claim.

Allowable Subject Matter

7. Claims 7-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach or suggest an analyzing device having a rotating body that includes an inner space for applying negative pressure, a plurality of positioning portions for holding the target analyte and through-holes for connecting the positioning the positioning portions and the inner space, wherein the inner space accommodates a blockade member for selectively closing or opening the through-holes by movement relative to the rotating body.

Conclusion

9. Claims 1-6 and 13-17 are rejected. Claims 7-12 are objected to.

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure as general background information related to Applicant's field of endeavor.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-

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2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 5, 2007

pkw


Jill Warden
Supervisory Patent Examiner
Technology Center 1700